U. S. PTO Customer No. 25280

Case #2151

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:	Worrell et al.
Serial Number:	09/495257
Filed:	1/31/00
For:	**PROCESS FOR PRODUCING SANDED ELASTIC FABRICS, AND FABRICS MADE THEREFROM**
Group Art Unit:	Torres-Velazquez, N.
Examiner:	1771

Request for Reconsideration

Honorable Commissioner for Patents
Washington, D. C. 20231

Sir:

Responsive to the Official Action mailed June 18, 2001, reconsideration and withdrawal of the pending rejections are respectfully requested. In addition, Applicants request withdrawal of the finality of the rejection, in that the rejection of Claim 7 on new grounds was not necessitated by any amendment by Applicants.

Claims 1-21 are currently pending in the application. Of these Claims 1-6 were withdrawn from consideration following a Restriction Requirement. Therefore, Claims 7-21 are currently under consideration.

Premature Nature of Final Rejection

The Official Action mailed June 18, 2001 was made final on the basis that "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action." Applicants respectfully disagree with this contention for the following reasons. Claim 7 (which was a dependent claim, depending from originally-filed Claim 1) was presented in the application as originally filed. In response to a Restriction Requirement imposed by the Examiner, Claims 1-6 were withdrawn from consideration

during the initial substantive examination of the application.

In the first substantive examination of the remaining claims, the only rejection levied against Claim 7 was one under 35 USC § 112, second paragraph, because Claim 7 was dependent on a non-elected claim. Apart from this rejection as to form, there was no rejection made based upon prior art. Therefore, the Applicants presented Claim 7 in independent form, believing it to thus be in condition for allowance since no other rejections against it remained.

However, in this most recent Office Action, the Examiner has rejected Claim 7 on substantive grounds (i.e. as being unpatentable over U.S. Patent No. 5,352,518 to Muramoto et al., as will be discussed further below), and made this rejection final on the grounds that Applicants' amendment necessitated the new grounds of rejection. Applicants maintain that the finality of this rejection is improper, in that it constitutes a new grounds of rejection not necessitated by amendment, as prohibited by MPEP 706.07(a). As set forth in 37 CFR 1.75(c), "Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim." Therefore, Claim 7 was not in fact "amended" so as to require new substantive examination, rather, its form was changed. In other words, since the rules state that dependent claims are construed as including all of the features of the claim(s) that they incorporate by reference, Applicants' presentation of Claim 7 in independent form merely constituted the presenting of the same claim in "longhand" version as opposed to the "shorthand" dependent claim format. Because the scope of the claim was therefore not changed by way of Applicants' Response, it is therefore improper for the Examiner to impose a substantive rejection for the first time on this claim, and make if final. Therefore, it is respectfully requested that the finality of the rejection be withdrawn.

Rejections Based on Prior Art

Claims 8-10 were rejected under 35 USC § 102(b) as being anticipated by U.S. Patent No. 5,205,140 to Nielsen et al. Specifically, the Examiner admitted that the

specific claimed hairiness values were not taught, but stated that "as the product of Nielsen is of the same structure and chemistry as applicant's, and appears to be produced by a similar method, it is expected that the products of Nielsen have the same properties as those instantly claimed."

Applicants respectfully disagree with those contentions. As noted in the previously-filed Response, the process described in the Nielsen patent involves significant fiber cutting, and therefore does not describe a sanded fabric having a low level of hairiness as in the present claimed invention. Furthermore, Claims 8-10 recite sanded **elastic** fabrics. On page 2 of the originally-filed specification, Applicants described that "as used herein, the term elastic fabrics is meant to describe those fabrics containing elastic fibers, and the term "elastic knit fabrics" is intended to describe fabrics incorporating elastic fibers, regardless of the manner in which they are knit." There is no teaching or suggestion in the Nielsen patent to use that process to sand elastic fabrics of the variety described in the present application.

Furthermore, the Nielsen process involves vibrating the traveling fabric with the sueding roll "sufficiently to allow abraded particles to be released from the sueding roll." (Col. 2, lines 64-68 of Nielsen). As will be appreciated by those of ordinary skill in the art, if a roll were in fact vibrated against an elastic fabric such as the type described and claimed in the present invention, it would be expected that the fabric would stretch and move with the roll rather than vibrating in the manner described in the Nielsen et al. patent. Furthermore, Claims 8-10 recite that the hairiness value is less than about 0.1 across its width. As explained in the specification of the instant application, one disadvantage of prior attempts to sand elastic fabrics is that the elastic nature of the fabric makes it difficult to achieve consistment treatment across the width of the fabric. Because of the vibration described in the Nielsen patent, it is maintained that this method would likewise not be suitable for the production of a consistent treatment of an elastic fabric. Therefore, it is maintained that the Nielsen patent does not anticipate, nor render obvious, the sanded elastic fabric of the low hairiness levels set forth in Claims 8-10.

Claims 7-21 were rejected under 35 USC 103(a) as being unpatentable over U.S. Patent No. 5,352,518 to Muramoto et al. Specifically, the Examiner stated that Muramoto et al. "discloses a composite elastic filament with a rough surface", with the filament having "excellent elastic properties, a small surface friction coefficient and a matting effect due to diffuse reflection of light caused by the rough surface." From this the Examiner concluded that although Muramoto et al does not teach "the method of contacting a surface of an elastic fabric with a microfinishing film to abrade the fibers", it would "have been obvious matter of design choice to make an elastic fabric with improved hand by using the composite elastic filament with a rough surface, since MURAMOTO et al. teaches that these filaments have ridges at micro ranges that will obviously provide a fabric with the hairiness values claimed in this invention." In addition, the Examiner stated that "it appears that the invention would perform equally well with the use of these [the Muromoto] filaments."

Applicants respectfully traverse the rejections, and request their withdrawal for the following reasons. The Muromoto patent describes a filament construction having a rough outer surface. There is no disclosure or suggestion of a **sanded** fabric of the variety described and claimed by Applicants. In fact, Muramoto teaches away from this concept by attempting to provide a filament which will achieve particular aesthetic characteristics by virtue of the filament structure itself. Furthermore, the Muramoto et al. patent fails to disclose or suggest a fabric which has been sanded to achieve a particular level of hairiness. Therefore, the Muramoto patent fails to disclose or suggest the invention as claimed.

Because all of the claims are in condition are in condition for allowance for the reasons stated above, reconsideration and withdrawal of the pending rejections are earnestly solicited. Applicants also request that the finality of the rejections be withdrawn for the reasons described above. Should the Examiner find that any issues remain outstanding following consideration of this Response, she is invited to telephone the undersigned in the interest of resolving any such matters in an expedient manner.

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Respectfully requested,

October 18, 2001

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the following papers are being facsimile transmitted to the Patent and Trademark Office (fax No.: 703-872-9311) on October 18, 2001.

Melanie Lucas – Legal Department